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Docket No.: 061352-0046

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 53080
Yasuo TAKEBE, et al. : Confirmation Number: 5764
Application No.: 10/696,505 : Group Art Unit: 1795
Filed: October 30, 2003 : Examiner: Raymond Alejandro
For: METHOD OF OPERATING FUEL CELL SYSTEM AND FUEL CELL SYSTEM AND
FUEL SYSTEM

PETITION FOR SUPERVISORY REVIEW UNDER 37 C.F.R. § 1.181 OR UNDER 37
C.F.R. § 41.3

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

CERTIFICATION OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY THAT THIS PAPER IS BEING
FACSIMILE TRANSMITTED TO THE PATENT AND
TRADEMARK OFFICE ON THE DATE SHOWN BELOW

Nathaniel D. McQueen
TYPE OR PRINT NAME OF PERSON SIGNING CERTIFICATION
[Signature] Apr. 1, 2010
SIGNATURE DATE

This is a petition for supervisory review by the Chief Administrative Patent Judge under 37 C.F.R. § 1.181 or 37 C.F.R. § 41.3 from the Examiner's decision set forth in the Notification of Non-compliant Appeal Brief (37 C.F.R. § 41.37), wherein the Examiner asserted that the Appeal Brief was non-compliant because it did not contain a concise explanation of the subject matter defined in each of the independent claims involved in the Appeal.

FACTS

1. Appellants filed a Notice of Appeal on November 6, 2009, appealing the rejection of claim 107 under 35 U.S.C. § 103(a) as being unpatentable over Fuller et al. (USP No. 6,068,941) in view of JP 11-67252.

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2. Appellants timely filed an Appeal Brief on January 6, 2010.

3. In the January 6, 2010 Appeal Brief filed by Appellants, each limitation of claim 107 was recited, with the page and line number of the portion of the specification on which each limitation is supported listed immediately after each limitation.

3. On March 1, 2010, the Examiner issued a Notification of Non-compliant Appeal Brief ("the Notification") asserting that the Brief 1) does not contain a concise explanation of each independent claim (claim 107) which refers to the specification by page and line number.

4. In the Continuation Sheet of the Notification, the Examiner stated that the limitations of claim 107 in the Summary of Claimed Subject Matter do "not appear to have been pertinently-mapped to the as-filed specification. See MPEP 1205.02."

5. MPEP 1205.02 states, in-part, "[t]he specific items required by 37 CFR 41.37(c)(1) are:...(v) *Summary of claimed subject matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." (emphasis added).

6. In the Notification, the Examiner alleged that there is "some vague mapping of the limitations to the as-filed specification."

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7. In the Notification, the Examiner recites the same page and line numbers of the support of the limitations as are recited in the Appeal Brief.

8. In the Notification, the Examiner then stated that “there does not appear to be any “interconnection” between all the cited passages and sections of the as-filed specification to arrive at the claimed subject matter.”

9. In the Notification, the Examiner stated that “the cited sections of page 68 (Example 12) do not appear to directly disclose the specifics of fuel cell structure and step (A) as instantly claimed, much less the limitation “terminating feeding of the oxygen-containing gas to the cathode”.

10. In the Notification, the Examiner requested that Appellant correct the deficiencies indicated in the Notification.

APPELLANTS' POSITION

As is shown in Fact 5, the MPEP clearly states in § 1205.02 that there must be a “a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number”. As the Examiner pointed out, the Appellants have made specific reference to the exact page and line numbers of each of the limitations in claim 107. As such, Appellants are unsure as how an exact page and line number can be considered “vague” as is suggested by the Examiner (see, Fact 6).

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The Examiner then states that “there does not appear to be any “interconnection” between all the cited passages and sections of the as-filed specification to arrive at the claimed subject matter.”

Appellants respectfully submit that there is no requirement in US Patent law that there be an “interconnection” between all cited passages and sections in the specification. The MPEP is silent with respect to such an “interconnection”, nor is any definition of “interconnection” provided in the MPEP, Title 37 of the Code of Federal Regulations or Title 35 of the United States Code. The Examiner has apparently made the term, and the subsequent requirement, out of thin air.

The Examiner appears to define “interconnection” several ways in the Notification. For example, he states that the cited sections of page 6 are not “related”, are not “technically pertinent”, or, are not “fully applicable” to the cited sections on page 28 or 68. Moreover, these “definitions” themselves are not requirements listed in MPEP 1205.02, or elsewhere. There is no requirement that portions of the specification be “interconnected” as suggested by the Examiner. The only requirement for submitting a Summary of Claimed Subject Matter according to MPEP 1205.02 is that there be a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number. Appellants have met this requirement, which is documented by the Examiner in the Notification. Appellants would point out that the application as originally filed contained 106 claims and 115 pages of double spaced text. Moreover, the claims have undergone several amendments over the course of prosecution. As such, it would be highly unlikely that all of the limitations for the claim would be conveniently located in only one section of the specification.

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The Examiner has also stated that “the cited sections of page 68 (Example 12) do not appear to directly disclose the specifics of fuel cell structure and step (A) as instantly claimed, much less the limitation “terminating feeding of the oxygen-containing gas to the cathode” (Step B of claim 107). As pointed out in the Summary of Claimed Subject Matter, the specifics of fuel cell structure as instantly claimed are not on page 68, but rather, on page 6.

Furthermore, Step A and B of claim 107 recite:

(A) operating the fuel cell while feeding the oxygen-containing gas to the cathode, (Spec 68:20-23)

(B) terminating feeding of the oxygen-containing gas to the cathode (Spec 68:20-23)

Page 68, lines 20-23 of the specification recites “[a]s the restoring operation, the electric current was terminated, and nitrogen as the inert gas was fed to the oxygen electrode instead of air which had been fed to the oxygen electrode”.

As is clear from this passage, a restoring operation is occurring. Further, by feeding nitrogen instead of air to the oxygen electrode, that supports both “operating the fuel cell while feeding oxygen-containing gas to the cathode” (air to the oxygen electrode), as well as terminating feeding of the oxygen-containing gas to the cathode” (feeding nitrogen *instead of* air). Accordingly, Appellants submit that the cited sections of page 68 support the claim limitations listed above.

REQUEST FOR RELIEF

Based on the foregoing, Appellants respectfully solicit the Honorable Chief Administrative Patent Judge to exercise authority under 37 C.F.R. § 41.3 and direct the Examiner to withdraw the Notification of Non-compliant Appeal Brief. Moreover, Appellants submit that

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the undue burden forced upon the Appellant by the Examiner is excessive, punitive, and not based on United States patent law. Appellants note that the Federal Register recently amended the rules to provide sole authority to the Chief Judge of the Board of Patents and Interferences to determine whether Appeal Briefs files in patent applications comply with the applicable regulations. Appellants welcome this change, as Appellants believe that abuses, such as the present case, will be significantly reduced or eliminated.

Fairness to Appellants and the demands of compact prosecution dictate that the Appeal Brief be found compliant.

Appellants note that 37 C.F.R. § 41.3 dictates that no fees be charged for supervisory review of a Petition of an Appeal Brief. However, to the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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